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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,097	01/31/2002	Meichun Hsu	10007908-1	6024

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/066,097	HSU ET AL.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/31/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/31/2002 was filed after the mailing date of the application on 1/31/2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the four statutory classes of invention as set forth in § 101 (i.e. (1) a process, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter).

In the present case, system claim 11 is directed to a "program or module", which is not within one of the classes of invention set forth in § 101.

The "program or module" comprising the following elements:

- a) a client organization that provides at least one search parameter for an electronic service;
- b) at least one service provider organization for publishing an e-service description in a predetermined format; and

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c) a discovery agent for use by the client organization; wherein the discovery agent receives the search parameter and provides at least one e-service that matches the search parameter.

are merely a disembodied abstract idea and do not produce a (1) useful and (2) tangible, and (3) concrete result.

Claim Rejections - 35 USC § 112

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 1, it's not clear the relationship between "prospective e-services" of (b) and "prospective services" of (c.) or (d)?

3. (2) Claims 12-14 recites the limitation "the client agent" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1-10, 11-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over www.google.com (Jan. 19, 2001) (by web.archive.org).**

Claim 1 reads as followed:

1. A method for publication and discovery of e-services in a system having a client organization, a discovery agent, a client agent, and one or more service provider organizations that provide e-services, the method comprising the steps of:

a) the service provider organizations publishing at least one e-service description in a predetermined format;

b) the client organization employing a discovery agent to find prospective e-services based on one or more search parameters;

c) the discovery agent providing prospective services that satisfy the search parameters; and

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d) the client organization utilizing the client agent to programmatically connect to one or more prospective services by employing a protocol that is compatible with the service provider organizations.

Similarly, www.google.com discloses:

a method for publication and discovery of e-services in a system having a client organization (your site), a discovery agent, a client agent, and one or more service provider organizations that provide e-services, the method comprising the steps of:

a) the service provider organizations (google.com) publishing at least one e-service description in a predetermined format {page 3/11, left column with description of services provided by google.com};

b) the client organization employing a discovery agent to find prospective e-services based on one or more search parameters {either (1) Custom Websearch or (2) Custom SiteSearch};

c) the discovery agent providing prospective services that satisfy the search parameters {inherently included to carry out/provide the result of the search}; and

d) the client organization utilizing the client agent to programmatically connect to one or more prospective services by employing a protocol that is compatible with the service provider organizations {inherently included when the result of the search is provided upon a request by a "your site visitor" searching on the Internet on WebSearch or SiteSearch, as shown on page 3}. Surely, the protocol has to be compatible with the service provider organization (google.com) for the system to work. Alternatively, it

would have been obvious to a skilled artisan to set up a protocol that is compatible for the client organization to work with the google.com.

As for dep. claims 2-3 (part of 1 above) which appear to be dealt with further limitation of the e-services, i.e. to be published in a location, since this is passively written "are published", they are interpreted as "being capable of" and have very little patentable weight in a method claim. Moreover, these are taught in google.com as www.google.com.

As for dep. claim 4 (part of 1 above) deal with well known search parameter, i.e. keywords, category, etc., these are taught in www.google.com, pages 3, 6-7.

As for dep. claims 5-7 (part of 1 above) deal with well known protocol features, these are inherently or taught in www.google.com, pages 3, 6-7. Moreover, the use of other well known protocol features would have been obvious as mere using other similar well known protocol features.

As for dep. claims 8-10 (part of 1 above) deal with well known information description on the Internet and wherein the information are about the e-services, these are inherently or taught in www.google.com, pages 3, 6-7. Moreover, the use of other well known protocol features would have been obvious as mere using other similar well known protocol features.

As for independent system Claim 11, it reads as followed:

11. A system for comprising:

a) a client organization that provides at least one search parameter for an electronic service;

b) at least one service provider organization for publishing an e-service description in a predetermined format; and

c) a discovery agent for use by the client organization; wherein the discovery agent receives the search parameter and provides at least one e-service that matches the search parameter.

Basically, this reads over the system to carry out the independent method claim 1 as cited above, and therefore, it's rejected over the respective system of www.google.com used to carry out the rejection of method claim 1 cited above.

As for dep. claims 12-14 (part of 11 above) which appear to be dealt with further limitation of the discovery agent and the client agent, since these are passively written "are disposed", they are interpreted as being capable of and have very little patentable weight in a system claim. Moreover, these are taught in google.com as www.google.com.

As for dep. claims 15-17 (part of 11 above) which appear to be dealt with further limitation of the discovery agent, these are taught in the searching engine of google.com as www.google.com. Moreover, the use of other well known searching units/generators would have been obvious as mere using other similar well known protocol features.

As for dep. claims 17-20 (part of 11 above) which basically have the similar limitations as in dep. claims 7-10 respectively cited above, they are rejected for similar reasons as shown in dep. claims 7-10 above.

No claims are allowed.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

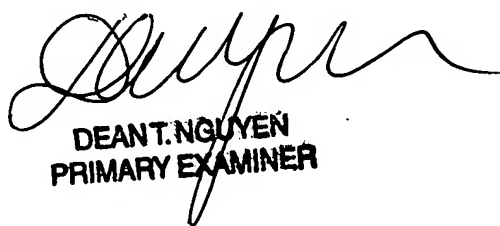
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
August 7, 2006



DEANT. NGUYEN
PRIMARY EXAMINER